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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/973,458

04/03/2001

Venkata Katikaneni

F-113

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08/11/2005

PITNEY BOWES INC.

35 WATERVIEW DRIVE

P.O. BOX 3000

MSC 26-22

SHELTON, CT 06484-8000

EXAMINER

COSIMANO, EDWARD R

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,458

Applicant(s)

KATIKANENI ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-37 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 120 is acknowledged.

2. The proposed drawings filed 20 September 2004 are acceptable.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(b-f).

4 Claims 13-33 & 35-37 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4.1 In regard to claims 13-24, although one of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, that is essential information/data and/or structure is missing so that as claimed invention does not work as a whole toward accomplishing the desired results and therefore one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using what applicant has disclosed and claimed as the invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claims 13 & 21 and how a "printer" which is located in proximity to the path of travel can print a "postage indicia" and an "ad slogan" at a location on an envelope indicated by the operator (claim 13) or in "one pass" and "another pass" (claim 21), since the invention as recited in these claims clearly fails to indicate or require that the printer is in fact actually located so that an envelope that is being transported along the path of travel will pass the print head of the printer in the recited "print position" so that the print head may in fact operatively print a "postage indicia" and/or an "ad slogan" at the location on an envelope that was indicated by the operator so as to provide a claimed invention that would achieved the creditable utility that has been set forth in the preamble of the claim.

B) in regard to claims 13 & 21 and how these claims recites a “postage printing” machine/process, comprising a “printer” that is located in proximity to the path of travel can print a “postage indicia” and an “ad slogan” at a location on an envelope indicated by the operator (claim 13) or in “one pass” and “another pass” (claim 21), since the invention as recited in these claims clearly fails to positively recite either:

(1) a means to detect when the envelope that is being transported along the path of travel would be properly positioned in the print position so that the print head of the printer may operatively print a “postage indicia” and/or an “ad slogan” at the location on an envelope that was indicated by the operator;

(2) means to control the printer in regard to when to start and/or stop printing a “postage indicia” and/or an “ad slogan” while the envelope is being conveyed along the path of travel so that they would appear at the location on an envelope that was indicated by the operator;

(3) a means to control the printer to in fact print either the “indicia” or “ad slogan”,

so as to provide a claimed invention that would achieved the creditable utility that has been set forth in the preamble of the claim.

C) in regard to claims 14-23, 26-32 & 34-36 and how the control system of the machine/process as recited in these claims could distinguish between either an “one pass” or an “another pass” through the postage printing system so as to accomplished the printing (claims 14, 18, 23, 26, 29, 32, 34, 35 & 36) or providing indication of the “anticipated orientation” (claims 15, 21, 27 & 34) or bypassing the printing of the ad slogan (claims 16, 19, 22, 28, 31, & 35), since the invention as recited in this claim clearly fails to recite any structure or function of the machine/process that would permit the control system to make a determination of whether a pass is the “one pass” or the “another pass” through the postage printing system, so as to provide a claimed invention that would achieved the creditable utility that has been set forth in the preamble of the claim.

4.2 Claims 13-17, 19, 20, 25-29, 31 & 32 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:

A) in regard to claims 13-17, 19 & 20 recite a postage printing system, however these claims fail to actually require the printing of a postage indicia, since:

(1) claim 13 recites a wall, transport device, a printer and a control system, where the printer is capable of printing an indicia but as recited in the claim does not print a postage indicia and the control system merely determines whether one or two print passes are required;

(2) claim 14 merely recites how the printer is controlled;

(3) claim 15 merely recites providing information to the user about the orientation of the envelope;

(4) claims 16, 17, 19 & 20 merely recite detecting the orientation of the envelope and controlling how the data is to be printed

B) in regard to claims 25-29, 31 & 32 recite a postage printing system, however these claims fail to actually require the printing of a postage indicia, since:

(1) claim 25 recites a transport device, defining possible print positions, obtaining a indication of the location of message/slogan/ad; and determining whether one or two print passes are required;

(2) claim 26 merely recites how the printer is controlled;

(3) claim 27 merely recites providing information to the user about the orientation of the envelope;

(4) claims 28, 29, 31 & 32 merely recite detecting the orientation of the envelope and controlling how the data is to be printed

For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

4.3 For the above reasons, applicant has failed to particularly point out what is regarded as the invention.

5. 35 U.S.C. § 101 reads as follows:

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"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

5.1 Claims 25-37 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

5.1.1 For the purposes of the following analysis it is noted that:

A) in regard to how claims are to be interpreted by the U.S. Patent & Trademark Office when determining whether or not the claims recite statutory subject matter the Court of Customs and Patent Appeals (CCPA) which is the predecessor of the Court of Appeals for the Federal Circuit (CAFC) set forth that "This passage has sometimes been misconstrued as a "rule" or "definition" requiring that all processes, to be patentable, must operate physically upon substances. Such a result misapprehends the nature of the passage quoted as dictum, in its context, and the question being discussed by the author of the opinion. To deduce such a rule from the statement would be contrary to its intendment which was *not to limit* process patentability *but to point out that a process is not limited to the means used in performing it*" and again "the claims are to be given their broadest reasonable interpretation consistent with the specification during examination of a patent application", and again "We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim.", In re Prater, 56 CCPA 1381, 1395-96, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (1969). Where the broadest reasonable interpretation was latter further defined by the CAFC to be:

(1) different from the way claims are to be interpreted by the Court in infringement suits, In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the

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art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification."); and

(2) limited to "The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.", In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)",

B) further in regard to the nature of statutory subject matter the Supreme Court in Diamond, Commissioner of Patents and Trademarks v. Diehr and Lutton, 209 USPQ 1, 9, (US SupCt, 1981) makes the following statement, "Our earlier opinions lend support to our present conclusion that a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula, computer program or digital computer.", from this statement it can be seen that the manner in which a process or machine may be implemented or may not be implemented is not a factor that may be used to determine if the claim as a whole recites statutory subject matter.

C) the CCPA further held that "We view the results here as being similar to those in Gelnovatch -- a simulation of something physical is produced by a process akin to mathematical modeling. Each and every step in these claims involves or intimately relates to mathematical operations; we can view the end product in this case only as a mathematical result.", and again "These claims are directed to the process of cross-correlation in the abstract. They are not limited to any particular art or technology, unless pure mathematics is considered as an art or technology. The "signals" processed by the inventions of claims 10-12 may represent either physical quantities or abstract quantities; the claims do not require one or the other. The claims thus dominate the particular method of cross-correlation in any and all arts. They are classic examples of an attempt to embrace the algorithm or scientific truth itself rather than a particular application.", In re Walter, 205 USPQ 397, 409 (CCPA 1980) {emphasis added}.

5.1.2 At this point, it is noted at this point that the CAFC has held in AT & T Corp. v. Excel Communications Inc. 50 USPQ2d 1447 @ 1452 (CAFC 1999) that "[1] In both *Alappat* and *State Street*, the claim was for a machine that achieved certain results. In the case before us,

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because Excel does not own or operate the facilities over which its calls are placed, AT & T did not charge Excel with infringement of its apparatus claims, but limited its infringement charge to the specified method or process claims. Whether stated implicitly or explicitly, we consider the scope of Section 101 to be the same regardless of the form -- machine or process -- in which a particular claim is drafted. See, e.g., *In re Alappat*, 33 F.3d at 1581, 31 USPQ2d at 1589 (Rader, J., concurring) ("Judge Rich, with whom I fully concur, reads Alappat's application as claiming a machine. In fact, whether the invention is a process or a machine is irrelevant. The language of the Patent Act itself, as well as Supreme Court rulings, clarifies that Alappat's invention fits comfortably within 35 U.S.C. Section 101 whether viewed as a process or a machine."); *State Street*, 149 F.3d at 1372, 47 USPQ2d at 1600 (" [F]or the purposes of a Section 101 analysis, it is of little relevance whether claim 1 is directed to a 'machine' or a 'process,'"). Furthermore, the Supreme Court's decisions in *Diehr*, *Benson*, and *Flook*, all of which involved method (i.e., process) claims, have provided and supported the principles which we apply to both machine- and process-type claims. Thus, we are comfortable in applying our reasoning in *Alappat* and *State Street* to the method claims at issue in this case." {emphasis added}, hence, both process and machine claims are to be treated the same and not to be treated differently based on the how the claim is drafted.

5.1.3 The instant claims recite a method comprising a series of steps to be performed, (claims 25-37), which has a disclosed practical application in the technological or useful arts. Further, the instant claims do not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon.

5.1.4 In regard to claims 25-37, the invention as set forth in these claims merely describes:

A) in regard to claims 25-37 a process of transporting an envelope through a print position of a postage printing system comprising obtaining an indication of the location an "ad slogan" is to be printed and determining if an indicia and add slogan may be printed in a single pass, with out requiring the use of the results of the obtained indication of "single pass" determination to control the operation of the postage printing system to in fact print postage.

However, the process as recited in these claims does not require that the result of either the claim as a whole or the manipulations of data as recited in these claims be applied in any manner so as

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to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a concrete and tangible application with in the technological or useful arts.

5.1.5 It is further noted that applicant has not recited in these claims a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either:

- A) altered or changed or modified by the invention recited in claims; or
- B) utilizes the result of the invention recited in these claims; or
- C) is operated or controlled by the result of the invention recited in these claims.

5.1.6 It is further noted in regard to claims 25-37, that as claimed applicant has not claimed:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or transformed/changed before it is processed by the claimed invention; or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation, is either manipulated or used nor changed by any device after it has been processed by the claimed invention; or

C) an actual practical use of the claimed invention by any physical system or device or method outside of the claimed invention other than a statement of the intended use of the claimed invention; or

D) process steps or physical acts/operations by the claimed invention that would affect the internal operation of a computer/machine as were found to be statutory in either In re McIlroy 170 USPQ 31 (CCPA, 1971) or In re Waldbaum 173 USPQ 430 (CCPA, 1972); or

E) process steps or physical acts/operations by the claimed invention that would be considered as going beyond the manipulation of “abstract ideas” as were found to be non-statutory in In re Warmerdam 31 USPQ2d 1754 (CAFC, 1994); or

F) a concrete and tangible practical application of either:

- (1) the invention as a whole; or
- (2) the final results of the manipulations/actions with in the technological or useful arts;

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note In re Sarkar 200 USPQ 132 (CCPA, 1978) where the process step of “constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model” was held to be so tenuous connected to the remaining process steps as to not be a process within the scope of 35 U.S.C. § 101.

Hence, the invention of claims 25-37 is merely directed to an hypothetical mental exercise that manipulates an abstract idea of determining the number of passes and proper orientation that is required in order to print data/information, that is not required to be physically implemented by the claimed invention and hence is without a claimed concrete and tangible practical application of the abstract idea, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

5.1.7 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

5.1.8 In practical terms, claims define nonstatutory processes if they:

A) consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or

B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application of the mathematics or abstract idea.

5.1.9 In view of the above analysis claims 25-37, as a whole, are directed to an hypothetical mental exercise that merely manipulates mathematics or an abstract idea without a claimed concrete and tangible practical application of the mathematics or abstract idea, and hence are directed to non-statutory subject matter.

5.2 Claims 13-24 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

5.2.1 As set forth by the Court in:

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A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), “We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory “process” within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” Cons. Art. 1, sec. 8.”, {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 “14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of “post-solution activity,” like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

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5.2.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the "specified adjusted location" in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

5.2.3 As can be seen from claims 13-24, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 13-24 under 35 U.S.C. § 112 2nd paragraph, are not clearly and definitely interconnected to one another so as to provide a claimed invention that would achieved the creditable utility that has been set forth in the preamble of the claim. Therefore, these claims do not provide an operative useful machine/process/manufacture, see In re Musgrave, supra, with in the meaning of machine/process/manufacture as used in 35 U.S.C. § 101, see In re Sarkar, supra.

5.3 Claims 13-17, 19, 20, 25-29, 31 & 32 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since they lack substantial and practical utility.

A) it is respectfully noted that claims 13-17, 19, 20, 25-29, 31 & 32 lack utility since these claims do not require the printing of postage so as to provide a claimed invention that would achieved the creditable utility that has been set forth in the preamble of the claim.

In view of the above, it is considered that the invention of claims 13-17, 19, 20, 25-29, 31 & 32 lack substantial and practical utility.

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1 Claims 13, 14, 25 & 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee et al (5,168,804) in view of Storace et al (4,831,554) as suggested by Kara (5,717,597) and further in view of Cannon et al (5,748,484) as evidenced by Pierce et al (6,154,733).

6.1.1 In regard to claims 13 & 25, Lee et al ('804) discloses a computer implemented machine/process that under the control of an operating program stored in the memory accessible by the machine/process provides the function of a postage metering system. In the postage metering system of Lee et al ('804) a transportation system is controlled in order to move an item of mail along a path that includes the use of a wall to register the item of mail and a postage meter. When the item of mail is positioned in a print position, then the postage printer is controlled to properly print a postage indicia and/or a personalized message/advertisement/slogan. Although the postage printing system of Lee et al ('804) teaches that the user selects a personalized message/advertisement/slogan that is automatically positioned, the system of Lee et al ('804) uses print dies that do not easily allow for the user to select variable message/advertisement/slogan to be printed with the postage indicia. It is noted that the user's selection to either not to print an advertisement/message/slogan on the item of mail or to print an advertisement/message/slogan/slogan on the item of mail is in fact an indication of a selected print position for the advertisement/message/slogan since, the physical operation of the system of Lee et al ('804) places the print element containing the advertisement/message/slogan next to the print element that contains the postage indicia, hence if

the advertisement/message/slogan is to be printed, then the advertisement/message/slogan would be positioned next to postage indicia.

6.1.2 It is noted that the fixed printing element that is used in the printing system of Lee et al ('804) will not support the wide selection of the content of the advertisement/message/slogan that is to be printed by the postage printing system of Lee et al ('804). However in the environment of postage metering systems, Storace et al ('554) discloses a computer implemented machine/process that under the control of an operating program stored in the memory accessible by the machine/process provides the function of a postage metering system with the ability to print different advertisements/messages/slogans. To this end, in the postage metering system of Storace et al ('554) an user designated message is loaded into the memory of the postage meter. When postage is to be printed by printing a postage indicia then advertisement/message/slogan that has been loaded into the memory is printed along the postage indicia. It is noted that this method of printing of the postage indicia and advertisement/message/slogan is accomplished in Storace et al ('554) by the desirable and beneficial modification of a postage printer that uses a fixed printing element such as the printing element in the postage metering system of Lee et al ('804) to use a digital printer such as a ink jet printer or thermal printer when printing postage indicia and advertisement/message/slogan. In this manner the user is provided with the greater flexibility when selecting the advertisement/message/slogan that is to be printed with the postage indicia.

6.1.3 In the environment of postage metering systems, Kara ('597) discloses a computer implemented machine/process that under the control of an operating program stored in the memory accessible by the machine/process provides the function of a postage metering system with the ability to print different user selected advertisements/messages/slogans. In the postage metering systems of Kara ('597) it is suggested that it would be a desirable feature of a postage metering machine/process to permit an user to personalizing the item of mail, for example a card, by selecting the advertisement/message/slogan that is to be printed on the item of mail. The selected message/advertisement/slogan is then printed with the postage indicia by the postage printer of Kara ('597).

6.1.4 Since, Kara ('597) disclose that it is desirable for the user or a postage metering system to be able to select the advertisement/message/slogan that is to be printed on an item of mail, it

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would have been obvious to one of ordinary skill at the time the invention was made that the printing element of the postage printer of Lee et al ('804) could be replaced by a digital printer as taught and suggested by Storace et al ('554) so as to provide the user with greater flexibility and ease in selecting the message/advertisement/slogan that is to be printed with the postage indicia as suggested by Kara ('597).

6.1.5 However, Lee et al ('804) as modified by the teaching of Storace et al ('554) as suggested by Kara ('597) does not disclose a control system that:

A) determines if one or two printing passes are required to print the combination of a postage indicia and advertisement/message/slogan at the desired location.

6.1.6 In the environment of personalizing items of mail, Cannon et al ('484) disclose a computer implemented machine/process that under the control of an operating program stored in the memory accessible by the machine/process provides a printing machine/process in which the user is permitted to select the location on an item at which a personalized advertisement/message/slogan is to be placed on an item when the advertisement/message/slogan is printed. To this end, in the system of Cannon et al ('484) as disclosed at column 11, line 46, to column 12, line 31, the user is permitted to select the location at which the images and/or text will appear on the item of mail when the images and/or text is printed on the item of mail. Such a machine/process that permits the user to exercise more control over the appearance of the item of mail.

6.1.7 In the environment of generating items of mail, Pierce et al ('733) disclose a computer implemented machine/process that under the control of an operating program stored in the memory accessible by the machine/process provides a printing machine/process in which any unused available space on an item of mail may be used as a suitable location/placement for a personalized advertisement/message/slogan, see fig. 2. Such a machine/process would permit the user to exercise more control over the appearance of the item of mail.

6.1.8 Since;

A) Kara ('597) discloses that it is desirable for the user or a postage metering system to be able to select the advertisement/message/slogan that is to be printed on an item of mail;

B) there may be limited available space at some locations on an item of mail, for example next to the postage indicia that would restrict the advertisement/message/slogan; and

C) as evidenced by Pierce et al ('733) in 1998 it was known that there are other areas on an item of mail that are available for the printing various advertisements/messages/slogans,

it would have been obvious to one of ordinary skill at the time the invention was made that the printing element of the postage printer of Lee et al ('804) could be replaced by a digital printer as taught and suggested by Storace et al ('554) could be further modified to permit the user to select the location on the item of mail at which the advertisement/message/slogan is to be printed as taught by Cannon et al ('484) so as to provide the user with greater flexibility and ease in selecting the advertisement/message/slogan that is to be printed with the postage indicia as suggested by Kara ('597) as well as the location at which the advertisement/message/slogan is to be printed from among a number of possible positions as evidenced by Pierce et al ('733).

6.1.9 In regard to the need to use one or two printing passes, it is noted that the physical components of the postage metering and printing system as well as the size of the message or advertisement to be printed govern how many printing passes are required to print the postage indicia and personalized message or advertisement. Hence, it would have been obvious to one of ordinary skill at the time the invention was made that the postage metering system of Lee et al ('804) as modified by the teaching of Kara ('597) in view of Storace et al ('554) and as modified by Cannon et al ('484) could be further modified to indicate to the user that one or more printing passes are required in order to print the postage indicia and personalized message or advertisement.

6.1.10 In regard to the order/sequence or the require number of passes of the printing device that are required for the postage indicia and personalized advertisement/message/slogan are to be printed as recited in claims 14 & 26, since the result of the postage metering system of Lee et al ('804) as modified by the teaching of Kara ('597) in view of Storace et al ('554) and as modified by Cannon et al ('484) as evidence by Pierce et al ('733) is to produce an item of mail with a postage indicia and a personalized advertisement/message/slogan, it would have been obvious to one of ordinary skill at the time the invention was made that the postage metering system of Lee

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et al ('804) as modified by the teaching of Kara ('597) in view of Storace et al ('554) and as modified by Cannon et al ('484) as evidence by Pierce et al ('733) could print the indicia or message in any sequence so long as both the indicia and message are placed in the item of mail.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

7.1 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example:

(1) Lee et al (5,168,804) discloses a postage metering system in which an user selects a personalized message or advertisement and the location that the message or advertisement is to be placed on an item of mail, where the prior art required the user to manually position the personalized message or advertisement, the current system would automatically position the personalized message or advertisement.

(2) either Hunter (5,493,106) or Kara (5,717,597) or Storace et al (4,831,554) or Cannon et al (5,748,484) disclose a postage metering system in which an user selects a personalized message or advertisement and the location that the message or advertisement is to be placed on an item of mail.

B) however, in regard to claims 15, 21, 27 & 34, the prior art does not teach or suggest indicating to the user the anticipated orientation of the item of mail during the subsequent printing passes. Claims 16-18, 22-24, 28-30 & 35-37 are allowable for the same reason.

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C) however, in regard to claims 16, 19, 22, 28, 31 & 35 the prior art does not teach or suggest using a scanner to detect distinguishing characteristics of the item of mail. Claims 17, 18, 20, 23, 24, 29, 30, 32, 33, 36 & 37 are allowable for the same reason.

D) however, in regard to claims 18, 24, 29, 33 & 37, the prior art does not teach or suggest printing the message or advertisement in a particular orientation based on the selected location to print the message or advertisement.

9. Response to applicant's arguments.

9.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

9.2 As per the 35 U.S.C. § 112 2nd paragraph rejection:

A) it is noted that the Patent Office may not read a limitation from the disclosure into the claims that is not expressly included into the claim, "We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim.", In re Prater, 56 CCPA 1381, 1395-96, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (1969), hence if the claim fails to expressly require that an machine/process perform a certain function, then that function may not be considered as part of a claimed invention.

B) in regard to the limitation of:

(1) claims 13 & 21 "a printer capable of printing a postal indicia and an ad slogan on the envelope, the printer being located in proximity to the path of travel so as to define a print position;"; and

(2) claims 25 & 34 "defining a print position where a postal indicia and an ad slogan may be printed on the envelope;";

it is noted that as provided by "Webster's Ninth New Collegiate Dictionary", Copyrighted 1986 by Merriam-Webster Inc. Publishers, Springfield, Massachusetts, the common meaning of the word:

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(1) "capable" at page 203, is "3: having attributes (as physical or mental) required for performance or accomplishment" and "5: having general efficiency and ability"; and

(2) "proximity" at page 949, "the quality or state of being proximate : closeness", where "proximate" at page 949 is defined as "1: immediately proceeding or following (as in the chain of events, causes, or effects" and "2: a very near : close",

hence neither of these word would require that the printer either be in the path or print a postage indicia and/or advertisement. Therefore as required by the Court when giving these words their broadest reasonable interpretation without reading the specification in to the claim, the printer is located somewhere near the "path of travel" but not necessarily with in the "path of travel" (claims 13 & 21) and the "postal indicia" and "ad slogan" are not required by the language of the claims to in fact be printed on the envelope (claims 13, 21, 25 & 34).

C) in view of points (A) & (B) above, an invention which may be seen as potentially providing a machine/process that may achieve a creditable utility may not be credited with achieving that creditable utility unless the claimed invention would expressly achieved the creditable utility that has been set forth in the preamble of the claim.

Hence, applicant's arguments are non persuasive.

9.3 As per the 35 U.S.C. § 103 rejection:

A) for the reasons set forth above in the modified rejection;
applicant's arguments are non persuasive.

10. Claims 15-20 & 27-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11.1 The fax phone number for **UNOFFICIAL/DRAFT FAXES** is (571) 273-6802.

11.2 The fax phone number for **OFFICIAL FAXES** is (571) 273-8300.

11.3 The fax phone number for **AFTER FINAL FAXES** is (571) 273-8300.

07/26/05


Edward R. Cosimano
Primary Examiner A.U. 3639